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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,167	09/26/2006	Alfred Thomas	247079-000249USPX	7246
70243	7590	08/31/2010		
NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			EXAMINER LANEAU, RONALD	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 08/31/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,167	<b>Applicant(s)</b> THOMAS, ALFRED	
	<b>Examiner</b> Ronald Laneau	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13,30-39 and 48-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13,30-39 and 48-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01142008</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. Claims 14-29, 40-47 and 54-57 are canceled in a preliminary amendment received on 09/28/06. Claims 1-13, 30-39 and 48-53 are now pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 30-39 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a

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particular apparatus. Thus, claims 1-19 are non-statutory since they may be preformed within the human mind.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13, 30-39 and 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiden et al (US 2005/0261047 A1) in view of Travis (US 5,380,007)

As per claims 1, 8, 9 and 30, Fiden discloses a gaming terminal for playing a basic wagering game and a bonus game, comprising: at least one display for displaying a randomly selected outcome for said basic wagering game, said randomly selected outcome being selected from a plurality of outcomes in response to receiving a wager input from a player, said plurality of outcomes including a start-bonus outcome ([0009] – [0011]); and wherein, in response to said start-bonus outcome being said randomly selected outcome. Fiden does not explicitly disclose displaying a lottery ticket with lottery numbers and balls randomly selected but Travis discloses at least one display displaying a lottery ticket with lottery numbers thereon and a real-life video of a lottery drawing in which number-bearing lottery and balls are randomly selected, said player achieving a bonus award in response to a match between at least some of said lottery numbers and said selected number-bearing lottery balls (see abstract, fig. 1).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a real life lottery drawing as thought by the system of Travis into the system of Fiden because it would provide a gaming terminal having a bonus feature that utilizes a ball control feature.

As per claims 2, Fiden discloses a gaming terminal further comprising a network interface for connecting said gaming terminal to a network of gaming terminals [0039]; further comprising a controller for randomly selecting said number-bearing lottery balls [0008]. wherein said controller resides in said gaming terminal (see fig. 1); wherein said controller resides on a network server to which several gaming terminals are connected (see fig. 1); wherein said controller randomly selects said lottery numbers on said lottery ticket [0008]; further comprising a player input mechanism for allowing said player to select said lottery numbers (system of Fiden is capable of such feature);

As per claims 10-12, Fiden does not explicitly a gaming terminal further comprising a player identification system for identifying said player, said player identification system causing said at least one display to display a customized greeting to said player (display system of Fiden is capable of such feature; see fig. 1); wherein said player identification system further causes said at least one display to display a lottery ticket having lottery numbers that are preselected by said player and stored within said player identification system (display system of Fiden is capable of such feature; see fig. 1); further comprising a video unit connected to said gaming terminal for processing said real-life video and providing full- screen, full-motion playback of said real-life video to said at least one display (display system of Fiden is capable of such feature; see fig. 1); wherein said video unit is a separate unit that is capable of providing said

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full-screen, full-motion playback on a stand-alone basis (display system of Fiden is capable of such feature; see fig. 1).

As per claims 31 and 32, Fiden discloses a method wherein said wagering game is a basic wagering game (see abs.); wherein said wagering game is a bonus game that is initiated upon occurrence of a predetermined outcome for a basic wagering game [0009].

As per claims 33-39, Fiden does not teach randomly selected lottery numbers but Travis discloses a method wherein said step of allocating includes randomly selecting said lottery numbers (see fig. 1); . The method according to claim 30, wherein said step of allocating includes allowing the player to manually select said lottery numbers (player has the options to select lottery numbers); wherein said plurality of real-life video clips includes a real-life close-up view of every possible combination of number-bearing lottery balls (see fig. 1); wherein said plurality of real-life video clips includes a real-life close-up view of certain ones every possible combination of number-bearing lottery balls (see fig. 1); wherein said step of randomly selecting an outcome includes said number-bearing lottery balls rolling from a drum of lottery balls down a chute path and into a chute, said plurality of real-life video clips including a close-up view of each number-bearing ball rolling down a portion of said chute path (see abs); wherein said plurality of real-life video clips includes an animated close-up view of every possible combination of number-bearing lottery balls (see fig. 1); wherein said plurality of real-life video clips are full-screen, full-motion video clips (see abs.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a real life lottery drawing as thought by the system of Travis into the system of Fiden for the same reasons given in claim 1.

As per claim 48, Fiden discloses a method of conducting a wagering game on a gaming terminal, comprising: storing, in a database, a set of player-preferred selections from an array of player-selectable options (see fig. 2, memory 35 can be a database storing the preferred selections by a player), said array used for determining a randomly selected outcome to said wagering game; retrieving said set of player-preferred selections from said database ([0009], see fig. 2). Neither Fiden nor Travis discloses applying said set of player-preferred selections to said wagering game; and determining an outcome of said wagering game based on said applying step but it would have been obvious to one of ordinary skill in the art to utilize such features for the same reasons previously given.

As per claims 49, 50, 52 and 53, Fiden discloses a method wherein said outcome of said wagering game is determined by comparing said player-preferred selections with randomly selected options from said array of player-selectable options [0029]; further comprising displaying said array of player-selectable options prior to said retrieving step [0003]; wherein said database is stored on a network to which said gaming terminal is connected (see fig. 2, 35); further comprising retrieving said set of player-preferred selections based on a player's identity (see fig. 2, retrieving from memory 35).

As per claim 51, Fiden does not disclose a lottery game but Travis discloses a method wherein said wagering game is a lottery game (see abs.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a real life lottery drawing as thought by the system of Travis into the system of Fiden for the same reasons given in claim 1.

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***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- See references cited on PTO form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571)272-6784. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald Laneau/  
Primary Examiner  
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